REMARKS/ARGUMENTS

In an Office Action mailed on December 30, 2003, Claims 15, 16 and 20-47 were canceled from consideration as being drawn to a non-elected invention. Claims 1-8, 10-14 and 17-19 were examined on the merits.

The Examiner withdrew rejections under 35 U.S.C. §103, but raised a new rejection against Claims 1, 2, 4, 10-14 and 17-19 under §112, first paragraph, alleging that the claims are not enabled. The Examiner also objected to Claims 3 and 5-9, but indicated that these claims are allowable if rewritten in independent form. Each issue raised by the Examiner is considered separately below.

Withdrawn Claims 15, 16, and 20-47 are here canceled without prejudice. Applicants reserve the right to pursue the subject matter of the canceled claims in a subsequent divisional patent application.

Rejections Under 35 U.S.C. §112, First Paragraph

The Examiner rejected Claims 1, 2, 4, 10-14 and 17-19 alleging that these claims are not enabled with respect to "other suitable lipoxygenase inhibitors" not listed in Claims 3 and 9. The Examiner stated that the application failed to define the term "lipoxygenase inhibitor" and did not provide information to allow the skilled artisan to ascertain the compounds that are lipoxygenase inhibitors without undue experimentation. The Examiner reasoned that the limited examples provided in the application were neither exhaustive nor define the class of compounds required such as by structure or by efficacy of lipoxygenase inhibition. The Examiner therefore concluded that it requires undue experimentation to practice the present invention. The applicants respectfully disagree with the Examiner.

The question of whether a claim is enabled should be analyzed in view of the limitations in the claim. It is not appropriate for the Examiner to reject a claim based on the nonenablement of a limitation not found in the claim. The claims at issue are directed at methods of controlling animal body fat. With respect to lipoxygenase inhibitors, the methods involve administering a lipoxygenase inhibitor to an animal in an amount sufficient to control body fat. By reciting the term "lipoxygenase inhibitor," the claims call for the use of any compounds that are either already known or will become to be known, independent of the present invention, as lipoxygenase inhibitors. A skilled artisan is of course familiar with the known lipoxygenase inhibitors and thus can readily practice the claimed method. It is noted that "determining whether a compound is a lipoxygenase inhibitor" is not one of the steps in

the claims. Therefore, no structural and other similar definitions for lipoxygenase inhibitors are necessary to enable the claims. By requiring such a definition, a limitation not in the claims would have to be impermissibly read into the claims.

With regard to the Examiner's concern that it is not known to what degree of inhibition a lipoxygenase inhibitor must have in order to be useful in the present invention, it is noted that an invention can be enabled even though some experimentation is necessary in order to practice the invention. In re Angstadt, 537 F. 2d 498 (CCPA, 1976). In determining whether the claims are enabled, the key inquiry is not whether any experimentation is necessary, but rather whether the experimentation is undue. In re Angstadt, 537 F. 2d 498 (CCPA, 1976). If the experimentation is merely routine, a considerable amount of experimentation is permissible. In re Wands, 858 F. 2d 731 (Fed. Cir. 1988). It is submitted here lipoxygenase assays and animal fat evaluations are routinely performed in the art. Whether a lipoxygenase inhibitor having a specific inhibition activity and/or at a specific dose can effectively control animal body fat in a particular animal can be readily determined by a skilled artisan through routine experimentation. For example, a routine dose-response experiment can be conducted for this purpose using any available lipoxygenase assay or animal fat evaluation systems such as that described in Example 2 of the application.

For all of these reasons, the enablement rejection imposed against the claims cannot stand and should be canceled. Reconsideration is respectfully requested.

Allowable Subject Matter

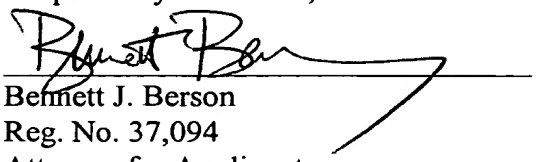
The Examiner indicated that Claims 3 and 5-9 are allowable if rewritten in independent form. Such claims are presented as new Claims 48-53, which are believed to be in condition for allowance. It is noted that if the Examiner is persuaded upon reconsideration of the rejections under §112, 1st paragraph, then these new claims will be unnecessary.

In view of the arguments and remarks provided above, applicants respectfully request that the enablement rejection be canceled and a Notice of Allowance be issued for Claims 1-14, 17-19 and 48-53.

No extension of time is believed to be necessary and no fee is believed to be due in connection with this response. However, if any extension of time is required in this or any subsequent response, please consider this to be a petition for the appropriate extension and a request to charge the petition fee to the Deposit Account No. 17-0055. No other fee is

believed to be due in connection with this response. However, if any fee is due in this or any subsequent response, please charge the fee to the same Deposit Account No. 17-0055.

Respectfully submitted,



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